

REMARKS

I. Introduction

Claims 10 to 22 are pending in the present application. In view of the preceding amendments and following remarks, it is respectfully submitted that claims 10 to 22 are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 10 to 22 Under 35 U.S.C. § 102(b)

Claims 10 to 22 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,144,667 ("Pogue, Jr. et al."). Applicant respectfully submits that Pogue, Jr. et al. do not anticipate claims 10 to 22 for the following reasons.

Claim 10 relates to a method for assigning a remote control operation to a base station. Claim 10 recites the steps of causing the base station to transmit a search, and returning a contact signal from the remote control operation in response to an agreement of the search signal with a stored reference signal. Claim 10 has been amended herein without prejudice to add the step of determining a randomized activation signal for an assignment. Claim 10 has been further amended herein without prejudice to recite that causing the base station to transmit a search signal is performed after the determining of the activation signal for the assignment. Support for the amendment may be found, for example, on page 5, lines 1 to 6 of the Specification.

The Office Action does not allege and Pogue Jr. et al. do not disclose or suggest the step of determining a randomized activation signal for an assignment. Pogue Jr. et al. describe a randomly chosen secret key S and a unique ID which are permanently programmed in the remote unit. Col. 2, lines 56 to 59. Because these values are permanently programmed, these values cannot be equated to the activation signal presented in claim 10, which recites "determining a randomized activation signal for an assignment." The base unit also has key P, ID and S, all of which are non-randomized numbers. Col. 5, lines 11 to 13. Of the remaining values provided in Pogue, Jr. et al., only R is a randomized number. As illustrated in Fig. 4, the only value transmitted by the base unit which can be randomized is the transmission of R,Q located in the box "xmit R,Q." Pogue Jr., et al. however do not determine the activation signal before the search signal is transmitted as required in amended claim 10. It is of particular note that the Office Action states that the search signal is produced when the remote unit enters the

radio range of the base unit, wherein the remote unit prepares for interrogation. As illustrated in Figure 4, the random number R is only generated during the authentication phase and not before. As a result, any potential random based numbers occur after the random number generation. Pogue, Jr. et al. only generate the value R when a reply is received. Col. 5, line 17 to 20. Pogue, Jr. et al. are silent regarding randomization and determination of activation signals **before** a search signal is transmitted from the base station.

Claim 16 relates to a base station. Claim 16 recites a transmitting/receiving device for transmitting a search signal and an activation signal capable of being changed, and for receiving a contact signal and a response signal from remote control operations. Claim 16 further recites an arrangement for performing one of a causing and an evaluating of each signal received by the transmitting/receiving device, wherein the arrangement for performing one of the causing and the evaluating determines the activation signal before a transmission of the search signal from the base station occurs, and the arrangement for performing one of the causing and the evaluating only recalls the activation signal for an assignment. Claim 16 further recites a non-volatile memory unit for storing fixed and changeable assignment information, the non-volatile memory unit assigning at least one of the remote control operations to the base station and making possible a test for matching.

Claim 18 relates to a system. Claim 18 recites a base station including: a first transmitting/receiving device for transmitting a search signal and an activation signal capable of being changed, and for receiving a contact signal and a response signal from remote control operations, a first arrangement for performing one of a causing and an evaluating of each signal received by the transmitting/receiving device, wherein: the arrangement for performing one of the causing and the evaluating determines the activation signal before a transmission of the search signal from the base station occurs. Claim 18 further recites that the arrangement for performing one of the causing and the evaluating only recalls the activation signal for an assignment. Claim 18 further recites a first non-volatile memory unit for storing fixed and changeable assignment information, the non-volatile memory unit assigning at least one of the remote control operations to the base station and making possible a test for matching. Claim 18 still further recites a second transmitting/receiving device for receiving the search signal and the

activation signal, and for transmitting the contact signal and the response signal, a second arrangement for performing one of an evaluating and a transmitting of signals received, and a second non-volatile memory unit for storing another set of assignment information and for assigning at least one of the remote control operations to the base station.

Both claims 16 and 18 require an arrangement which determines the activation signal before a transmission of a search signal from the base station. As provided above, Pogue, Jr. et al. do not provide a method step for determining an activation signal before a transmission of a search signal from the base station. Pogue, Jr. et al. furthermore do not provide any arrangement which provides for determining an activation signal before a transmission of a search signal from the base station.

It is "well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986) (citing In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Pogue, Jr. et al. do not disclose, or even suggest, all of the limitations of claims 10, 16 and 18. It is therefore respectfully submitted that Pogue, Jr. et al. do not anticipate claims 10, 16 and 18.

As for claims 11 to 15 and 19 to 22, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, it is respectfully submitted that Pogue, Jr. et al. do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 10.

As for claim 17, which depends from claim 16 and therefore includes all of the limitations of claim 16, it is respectfully submitted that Pogue, Jr. et al. do

not anticipate dependent claim 17 for at least the same reasons given above in support of the patentability of claim 10 and 16.

III. Conclusion

It is respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: 10/2/03

By:

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646